



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,804	12/10/2004	Kenji Adachi	3019.010USU	8937
27623 7590 09/02/2009 OHLANDT, GREELEY, RUGGIERO & PERLE, LLP ONE LANDMARK SQUARE, 10TH FLOOR STAMFORD, CT 06901				
EXAMINER				
DEES, NIKKI H				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/517,804

**Applicant(s)**

ADACHI ET AL.

**Examiner**

Nikki H. Dees

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed June 29, 2009, has been entered. Claims 8-13 are currently pending in the application. Claims 1-7 have been cancelled. The previous 112 rejections of claims 1-6 have been withdrawn in view of the cancellation of claims 1-6. The previous 102 rejections of claims 1-7 have been withdrawn in view of the cancellation of claims 1-7. The previous 103 rejections of claims 1-7 have been withdrawn in view of the cancellation of claims 1-7.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank et al. (WO 98/58656) in view of Mai et al. (US 4,839,187).
4. Bank et al. teach a citral flavor deterioration inhibitor (or stabilizing agent) (abstract) in the form of a water-soluble plant extract (p. 5 lines 22-24). They also teach a storage stable food composition with a citrus flavor that includes this extract (claim 16).

5. Bank et al. add the plant extract inhibitor to their composition at a concentration ranging from about 10 ppm to 500 ppm (claim 15).
6. Bank et al. teach that their extract inhibits the formation of the citral oxidative degradation product *p*-methylacetophenone (p. 5 lines 1-3).
7. Bank et al. are silent as to the use of an extract from semi-fermented tea leaves or fermented tea leaves. They also do not speak specifically to the use of their composition in fragrances and cosmetics.
8. Mai et al. teach an aqueous tea extract that is used as an antioxidant (Abstract). They further state that their invention has antioxidant activity similar to that of products obtained from rosemary, while also having a less intense flavor (col. 1 lines 49-51).
9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to try an extract from tea known to be an effective antioxidant, as taught by Mai et al., for the rosemary extract of Bank et al. in order to provide a citral containing product protected from flavor deterioration. As both the product of Bank et al. and the product of Mai et al. were known in the prior art to be effective for the same purpose (as antioxidants), one of ordinary skill would have found it obvious to utilize a known antioxidant with a less intense flavor where an antioxidant derived from rosemary was previously utilized. This would not have required undue experimentation, and there would have been a reasonable expectation that the composition of Mai et al. would have functioned effectively to inhibit the flavor deterioration as taught by Bank et al.
10. Regarding claim 11, one of ordinary skill in the art would have found it obvious to utilize known antioxidant to compositions wherein antioxidative protection is desired. As

the combination of Bank in view of Mai is suitable for addition to foodstuffs, one of ordinary skill would have had found it obvious to incorporate in compositions including fragrances and cosmetics that may come in contact with skin to minimize the possibility of adverse effects on the user of the fragrance or cosmetic.

11. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank et al. (WO 98/58656) in view of Hara (4,673,530).
12. Bank et al. teach a citral flavor deterioration inhibitor (or stabilizing agent) (abstract) in the form of a water-soluble plant extract (p. 5 lines 22-24). They also teach a storage stable food composition with a citrus flavor that includes this extract (claim 16).
13. Bank et al. add the plant extract inhibitor to their composition at a concentration ranging from about 10 ppm to 500 ppm (claim 15).
14. Bank et al. teach that their extract inhibits the formation of the citral degradation product *p*-methylacetophenone (claim 24).
15. Bank et al. are silent as to the use of an extract from semi-fermented tea leaves or fermented tea leaves. They also do not speak specifically to the use of their composition in fragrances and cosmetics.
16. Hara teaches an aqueous tea extract that is used as an antioxidant (Abstract; col. 1 lines 61-63). The composition is taught for use in foodstuffs, as well as in cosmetics (col. 2 lines 59-64).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted an extract from tea known to be an effective antioxidant, as taught by Hara, for the rosemary extract of Bank et al. in order to provide a citral containing product protected from flavor deterioration. As both the product of Bank et al. and the product of Hara were known in the prior art to be effective for the same purpose (as antioxidants), one of ordinary skill would have had a reasonable expectation the extract of Hara would have functioned effectively as an antioxidant to inhibit citral flavor degradation in the invention of Bank et al. Substituting a known ingredient for a known alternative ingredient which performs the same function would have been obvious to one skilled in the art. One skilled in the art would have been motivated to substitute the tea extract for the rosemary extract of Bank et al. when desiring a less intense flavor. Rosemary extracts are known in the art to have an intense flavor as shown in the Mai reference above.

### ***Response to Arguments***

18. Applicant's arguments filed June 29, 2009, have been fully considered but they are not persuasive.

19. Applicant argues that it would not have been obvious to replace the extract of rosemary with another antioxidant as all antioxidants do not protect equally against the oxidation of citral (Remarks, p. 7).

20. As Mai et al. specifically teach their product for use as an antioxidant where rosemary extracts are known to be used in order to avoid the strong flavor of rosemary, one of ordinary skill would have found it obvious to try the substitution of one known antioxidant for another. Obviousness requires only a reasonable expectation of success. Based on the teachings of Mai et al., one of ordinary skill would have had a reasonable expectation that a tea extract would have functioned effectively as an antioxidant where a rosemary extract was known to be used previously.

21. Applicant argues that the extraction method utilized by Mai is different than that of the instant application, and therefore the extract obtained would have different antioxidant properties (Remarks, p. 8).

22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the extraction conditions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23. As the instant claims are to an extract obtained from semi-fermented or fermented tea leaves, and Mai and Hara teach an extract obtained from tea leaves, the teachings of Mai and Hara are considered to meet the claim limitation requiring an extract from tea leaves.

***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H. D./

Nikki H. Dees  
Examiner  
Art Unit 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794